

ESTTA Tracking number: **ESTTA394616**

Filing date: **02/22/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Apple Inc.
Granted to Date of previous extension	02/20/2011
Address	1 Infinite Loop Cupertino, CA 95014 UNITED STATES
Attorney information	Bobby A. Ghajar and James R. Cady HOWREY LLP 1950 UNIVERSITY AVE., 4TH FLOOR EAST PALO ALTO, CA 94303 UNITED STATES CadyJ@howrey.com,GhajarB@howrey.com,RenojoR@howrey.com,IPDocketing@howrey.com Phone:(650) 798-3500

### Applicant Information

Application No	77786790	Publication date	08/24/2010
Opposition Filing Date	02/22/2011	Opposition Period Ends	02/20/2011
Applicant	ViXS Systems Inc. 1210 Sheppard Ave. East, Ste 800 Toronto, M2K1E3 CANADA		

### Goods/Services Affected by Opposition

Class 009.

All goods and services in the class are opposed, namely: Circuit boards; Circuit boards provided with integrated circuits; Computer software and hardware for enabling video, audio, and data distribution from personal video recorders, picture-in-picture, DVD players, televisions, handheld devices, namely, personal digital assistants, cellular phones and web pads; Computer software for use in the encryption and decryption of digital files, including audio, video, text, binary, still images, graphics and multimedia files; Computer software for audio and video manipulation; Computer software that assists computers in deploying parallel applications and performing parallel computations; Consumer electronic products, namely, audio amplifiers, audio speakers, audio receivers, electrical audio and speaker cables and connectors, home theater systems, audio decoders, video decoders, speakers, power conversion devices, power converters, and power inverters; Data compression software; Digital video recorders; Encoders; Encoding and decoding apparatus; Encoding and decoding apparatus and instruments; Integrated circuits; Integrated circuits, integrated circuit chips, and integrated circuit modules for digital video compression and decompression; Integrated circuits, integrated circuit chips, and integrated circuit modules for encoding and decoding digital video; Semiconductor chips; Semiconductors; Television decoder

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2950105	Application Date	06/30/2003
Registration Date	05/10/2005	Foreign Priority Date	06/13/2003
Word Mark	XCODE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/09/15 First Use In Commerce: 2003/09/15 Computer software for software development		

Attachments	SMART XCODE - Notice of Opposition.pdf ( 6 pages )(177893 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JRCady/
Name	Bobby A. Ghajar and James R. Cady
Date	02/22/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:

ViXS Systems Inc.

Serial No.: 77/786790

Filed: July 22, 2009

Mark: SMART XCODE

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International Class: 9

Published: August 24, 2010

Commissioner for Trademarks  
P. O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

Madam:

Opposer Apple Inc. (“Opposer” or “Apple”) is a California corporation with its principal place of business at 1 Infinite Loop, Cupertino, California 95014. Opposer believes that it will be damaged by the registration of the mark shown in Application Serial No. 77/786790 for certain goods in Class 9, filed July 22, 2009 by ViXS Systems Inc., (“Applicant” or “ViXS”) and hereby opposes this application under the provisions of 15 U.S.C. § 1063 (as amended).

The Commissioner for Trademarks is hereby authorized to draw on the deposit account No. 08-3038, Order No. 00380.0023.00US00/Cady for any necessary fees.

Application Serial No. 77/786790 was filed on July 22, 2009 for the word mark SMART XCODE for “Circuit boards; Circuit boards provided with integrated circuits; Computer software and hardware for enabling video, audio, and data distribution from personal video recorders, picture-in-picture, DVD players, televisions, handheld devices, namely, personal digital assistants, cellular phones and web pads; Computer software for use in the encryption and

decryption of digital files, including audio, video, text, binary, still images, graphics and multimedia files; Computer software for audio and video manipulation; Computer software that assists computers in deploying parallel applications and performing parallel computations; Consumer electronic products, namely, audio amplifiers, audio speakers, audio receivers, electrical audio and speaker cables and connectors, home theater systems, audio decoders, video decoders, speakers, power conversion devices, power converters, and power inverters; Data compression software; Digital video recorders; Encoders; Encoding and decoding apparatus; Encoding and decoding apparatus and instruments; Integrated circuits; Integrated circuits, integrated circuit chips, and integrated circuit modules for digital video compression and decompression; Integrated circuits, integrated circuit chips, and integrated circuit modules for encoding and decoding digital video; Semiconductor chips; Semiconductors; Television decoder” in International Class 9. The application was published for opposition on August 24, 2010.

Opposer has applied for and obtained the necessary extension of time in which to oppose Application Serial No. 77/786790 following its publication. This Notice of Opposition is timely filed on February 22, 2011, as the original deadline fell on Sunday, February 20, 2011 and Monday, February 21, 2011 was a federal holiday. *See* T.B.M.P. §112; 37 CFR §2.196.

As grounds for the opposition, it is alleged that:

1. Opposer is the world famous designer, manufacturer and distributor of a wide variety of goods and services, including but not limited to personal computers, mobile communication and media devices, portable digital music and video players, software, peripherals, networking solutions, third-party digital content and applications, and related services.

2. Opposer is the owner of U.S. Trademark Registration No. 2950105 for the mark XCODE, filed on June 30, 2003 and registered on May 15, 2005, covering “computer software for software development” in International Class 9. See attached Exhibit A. This registration is valid and subsisting and is now incontestable under the provisions of 15 U.S.C. §1065.

3. Opposer also has extensive common law rights in its XCODE mark, and uses this mark in connection with computer software for software development throughout the United States and abroad.

4. Applicant seeks to register the word mark SMART XCODE in connection with the goods in International Class 9 as set forth above on pages 1 and 2 of this Notice of Opposition. The subject application was published in the Official Gazette of the PTO on August 24, 2010.

5. Opposer is not affiliated or connected with Applicant or its goods; nor has Opposer endorsed or sponsored Applicant or its goods.

6. Opposer began using its XCODE mark, and enjoys priority as a result of the filing date of its trademark registration, well prior to the filing date of the application for the SMART XCODE Mark (July 22, 2009).

7. Registration of Applicant’s mark in International Class 9 will injure Opposer by causing the public to be confused or mistaken into believing that the goods provided by Applicant are endorsed or sponsored by Opposer. Opposer has no control over the nature and quality of the goods offered by Applicant under the SMART XCODE mark, and Opposer’s reputation and goodwill will be damaged and the value of its XCODE mark jeopardized, all to Opposer’s detriment.

8. Accordingly, registration of the mark herein opposed in International Class 9 would be a source of injury and damage to Opposer. Thus Applicant’s mark is unregistrable under Sections 2(d) of the United States Trademark Act, as amended, 15 U.S.C. §1052, and should be refused registration.

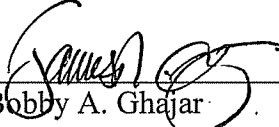
WHEREFORE, Opposer requests that this opposition be sustained and that the registration of Application Serial No. 77/786790 be denied.

Respectfully submitted,

APPLE INC.

Date: February 22, 2011

By: \_\_\_\_\_

  
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CERTIFICATE OF ELECTRONIC TRANSMISSION

DATE OF DEPOSIT: February 22, 2011

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above:

  
James R. Cady

CERTIFICATE OF SERVICE VIA MAIL

I, Rosario F. Renojo, secretary to James R. Cady, Esq., of Howrey LLP, attorneys for Opposer Apple Inc., hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION was served on Applicant, Mr. Ben Marchand, ViXS Systems Inc., 1210 Sheppard Ave. East, Ste 800, Toronto M2K1E3, CANADA, via postage prepaid by first-class mail on February 22, 2011.

  
Rosario F. Renojo

# **EXHIBIT A**

**Int. Cl.: 9**

**Prior U.S. Cls.: 21, 23, 26, 36, and 38**

**United States Patent and Trademark Office**

**Reg. No. 2,950,105**

**Registered May 10, 2005**

**TRADEMARK  
PRINCIPAL REGISTER**

**XCODE**

APPLE COMPUTER, INC. (CALIFORNIA CORPORATION)  
1 INFINITE LOOP  
CUPERTINO, CA 95014

FIRST USE 9-15-2003; IN COMMERCE 9-15-2003.

SN 78-268,896, FILED 6-30-2003.

FOR: COMPUTER SOFTWARE FOR SOFTWARE DEVELOPMENT, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

BRETT J. GOLDEN, EXAMINING ATTORNEY